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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,134	01/21/2000	William J. Baer	STL000012US1	S405
23373	7590	08/08/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PHAM, HUNG Q	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/489,134	BAER ET AL.
	Examiner	Art Unit
	HUNG Q. PHAM	2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-99 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-99 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/10/2006 has been entered.

Response to Arguments

- *Claim Rejections - 35 USC § 112*

Applicants' arguments with respect to the rejection of claims 1, 30, 31, 60, 61 and 90 under 35 U.S.C. § 112, first paragraph, have been fully considered and are persuasive in view of the amendment. The previous rejection of claims 1, 30, 31, 60, 61 and 90 under 35 U.S.C. § 112, first paragraph, has been withdrawn.

- *Claim Rejections - 35 USC § 103*

I. Applicants' arguments with respect to the rejection of claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 under 35 U.S.C. § 103 have been fully considered but they are not persuasive.

(a) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

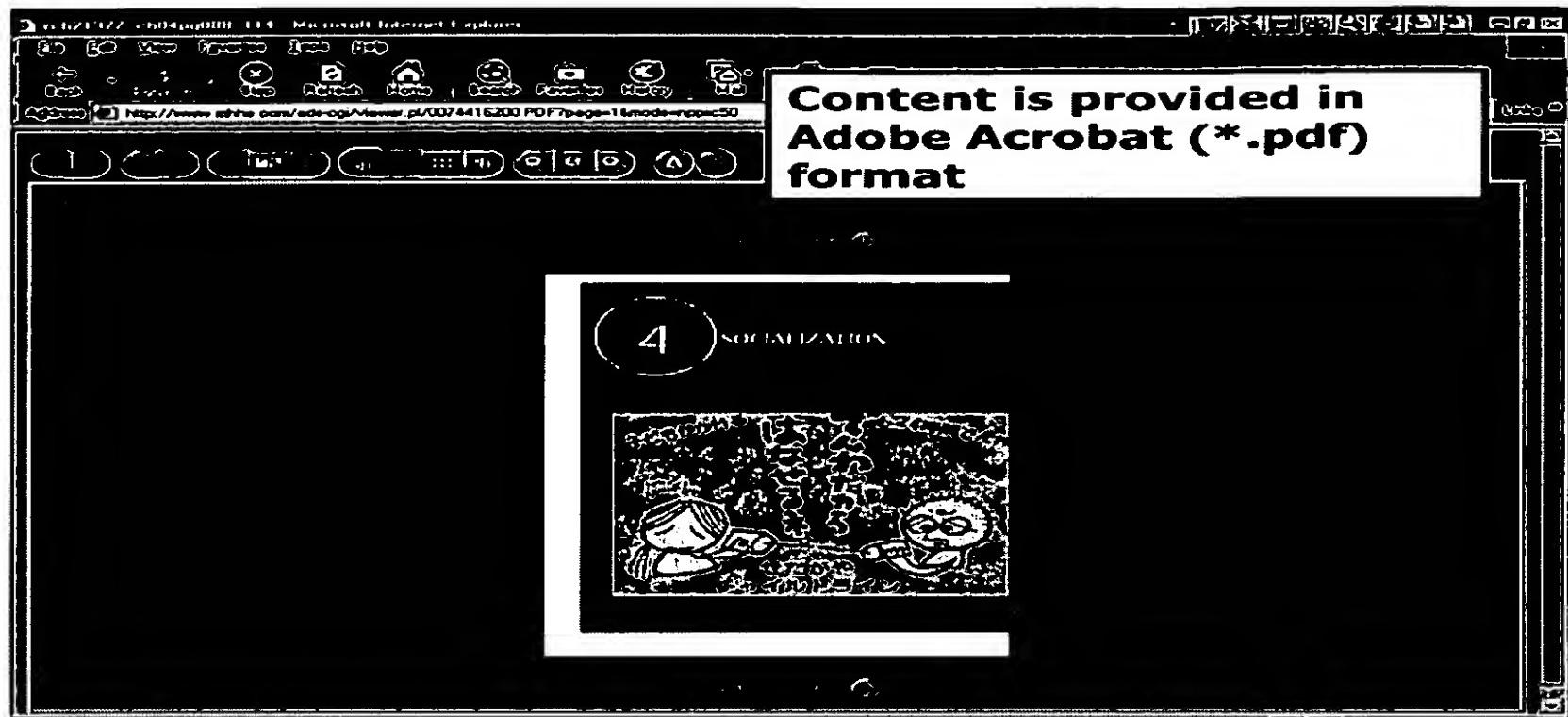
Art Unit: 2168

5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, as shown below is an e-book or *custom content object*, which is specified by book number 7908934, is created. The created e-book includes *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition". The e-book is provided in Adobe Acrobat format. In the knowledge generally available to one of ordinary skill in the art, the e-book or *custom content object* and the *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition", must be stored at the server side before downloading to the client side.

The screenshot shows a Microsoft Internet Explorer window displaying a Prims Online catalog page. The title bar reads "Prims Political Science - Online Texts - Microsoft Internet Explorer". The address bar shows the URL "http://www.mhhe.com/prims/catalog/pcatalog/D19-1.htm". The page header features the "Prims Custom PUBLISHING" logo and a slogan "Together we can create better educational tools." Navigation links include "Services Overview", "Custom Catalog", "Using Prims", "Showcase", "My Prims", "Your Custom Publisher", "eBookstore", and "Prims MBA". A menu bar with "File", "Edit", "View", "Favorites", "Tools", and "Help" is visible. Below the header, there are tabs for "Browse/Select", "Review", "Cover", and "Finished". A large "Political Science" category is selected. On the left, a sidebar lists "Science, Engineering and Math" and "Sig and thus and". A search bar is present. The main content area is titled "Review selected items" and displays a list of books with their details. A note says "Your book number: 7908934 Format: 8.5 x 11 inches Delivery: eBook" and "Note: This product is not available outside the U.S. and Canada." A note also states "Click here to delete all 4 items." The table of contents for the selected book includes chapters 2, 15, 10, and 8.

Program/Parent/Item	Digital List \$	Pages
Patterson: We The People, Third Edition		
2. Constitutional Democracy	0.43	4
Reading 2: The Mischiefs of Faction, James Madison (View)	0.43	4
15. Economic and Environmental Policy	0.43	4
Reading 15: Long-Term Goals for the Economy, Alice M. Rivlin (View)	0.43	4
10. The News/Media	0.43	4
6. Reading 10: The Miscalculation of Thomas E. Patterson (View)	0.43	4
Shively: Comparative Governance Theoretical Modules		
8. The Setting of Power: The State (View)	1.42	13



As disclosed by Santamaki at Col. 5, Lines 6-16, a centralized server for storing the electronic written materials, and an e-book server for storing selected electronic written materials that have been converted into an electronic book format to subsequent download to a terminal for viewing.

Thus, the Santamaki teaching of centralized server as *library server*, obviously, could be used for storing electronic written materials include *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition", and an e-book server as *object server*, obviously, could be used to store the e-book or *custom content object*.

(b) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge

gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

II. Applicants' arguments with respect to the rejection of claims 2-3, 29, 32-33, 59, 62-63 and 89 under 35 U.S.C. § 103 have been fully considered but they are not persuasive as discussed above.

III. Applicants' arguments with respect to the rejection of claims 4-5, 34-35 and 64-65 under 35 U.S.C. § 103 have been fully considered but they are not persuasive as discussed above.

IV. Applicants' arguments with respect to the rejection of claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 under 35 U.S.C. § 103 have been fully considered but they are not persuasive as discussed above.

In light of the foregoing arguments, the 35 U.S.C. § 103 rejection is hereby sustained.

Duplicate Claims, Warning

Applicant is advised that should claims 1, 31 and 61 be found allowable, claims 30, 60 and 90 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 30, 31, 60, 61 and 90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As in claims 1, 30, 31, 60, 61 and 90, the claim limitation *a header of said custom content object is user-modifiable* was not described in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

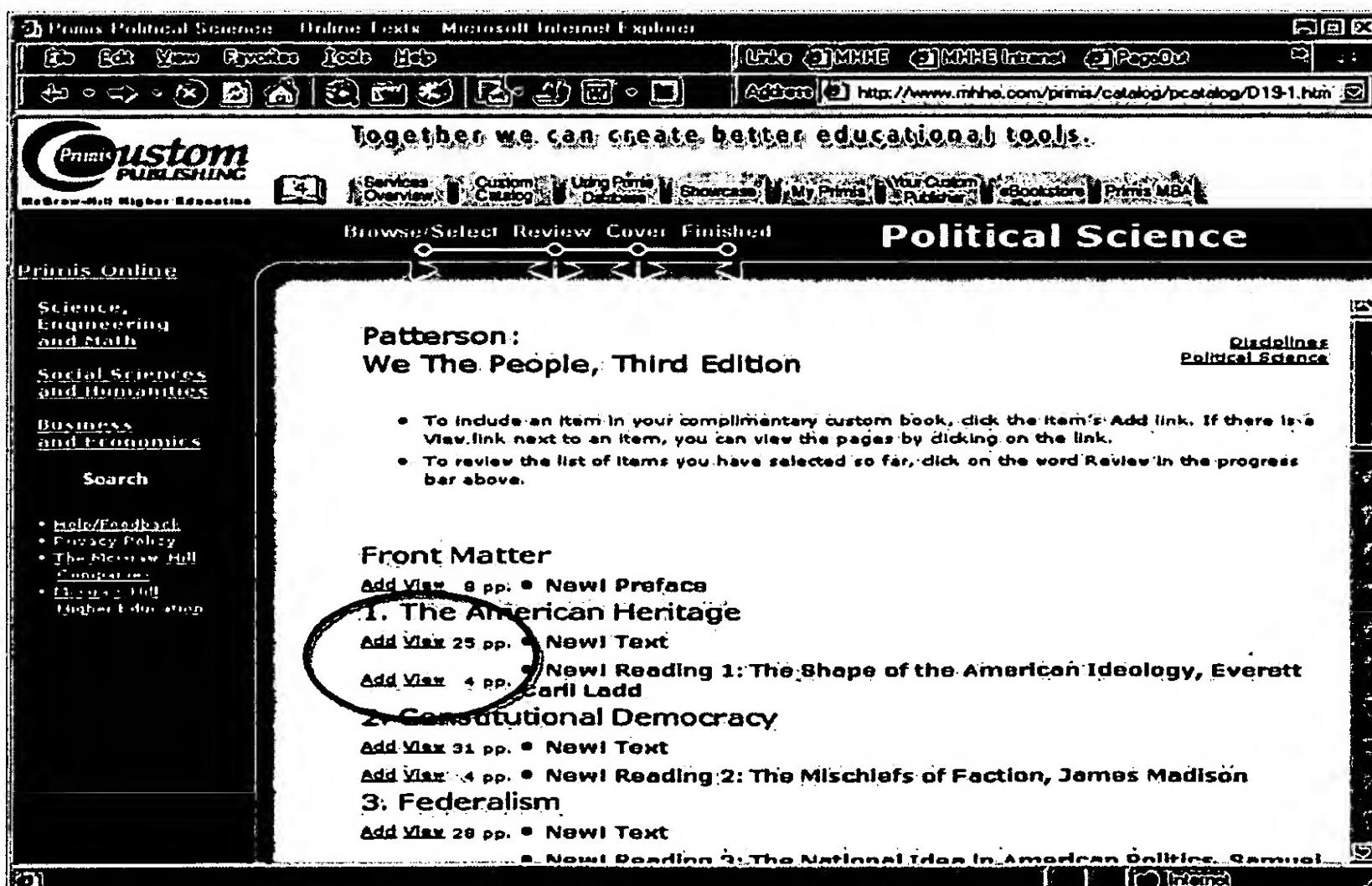
Art Unit: 2168

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

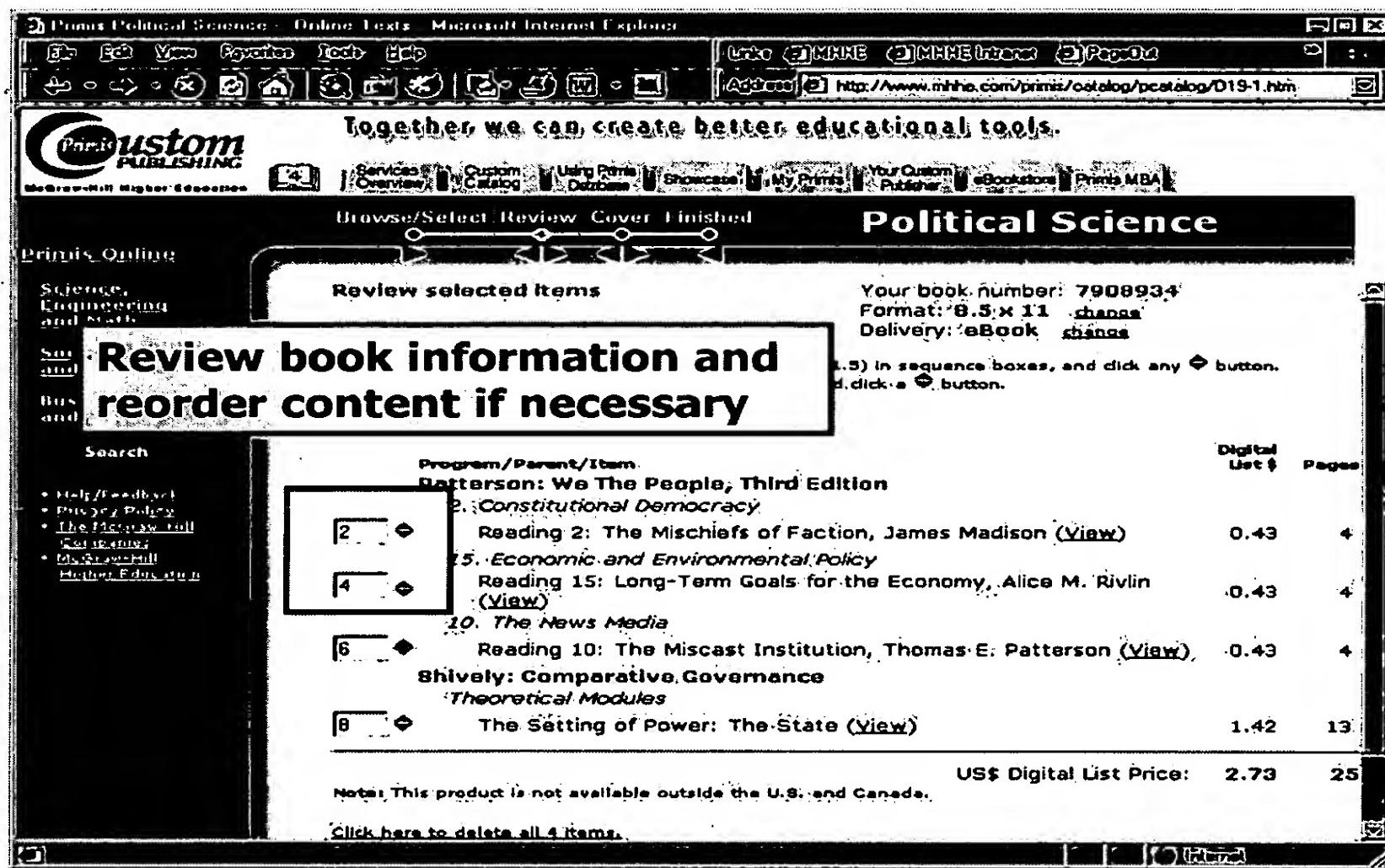
Claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing] and Warnock et al. [USP 5,634,064] in view of Santamaki et al. [USP 6,886,036 B1].

Regarding claims 1, 31 and 61, McGraw-Hill teaches a method and system for creating a customized textbook. The interface as illustrated at page 5 is *a collection of content*.

In order to create a customized textbook, the McGraw-Hill method has a GUI as below for *presenting a plurality of Chapter and Sections as selectable objects to a user each Chapter and Section as object representing Business Law as a subset of the collection of content*,



in response to selection by a user of one or more of chapters and sections as objects by using the add button, a custom content object that specifies a hierarchical compilation of the content represented by each selected object is created (based on the selected chapters and sections, the screenshot below indicates an e-book that has book number 7908934 as a custom content object is created. The created e-book specifies a hierarchical compilation of the content represented by each selected object);



As shown in the screen shot above, the created e-book includes *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition". The e-book is provided in Adobe Acrobat format.

The missing of McGraw Hill is *one or more object servers*, a *library server* for storing the e-book, information and attribute of the e-book, and *a header of the e-book is user-modifiable*.

Warnock teach the technique of modifying the header of an electronic document in PDF format (Warnock, Col. 2, Lines 15-37). Warnock further discloses the technique of modifying a

header of a PDF document by a user (Warnock, Col. 6, Line 66-Col. 7, Line 31). Thus, *a user modifiable header* is an inherited feature of document in PDF format.

As disclosed by Santamaki at Col. 5, Lines 6-16, a centralized server for storing the electronic written materials, and an e-book server for storing selected electronic written materials that have been converted into an electronic book format to subsequent download to a terminal for viewing.

Thus, the Santamaki teaching of centralized server as *library server*, obviously, could be used for storing electronic written materials include *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition", and an e-book server as *object server*, obviously, could be used to store the e-book or *custom content object*.

By using centralized server as *library server*, and an e-book server as *one or more object servers* for storing information, the selectable text books and custom text book could be stored separately to distinguish the information between compiling and downloading process.

Regarding claims 6, 36 and 66, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the collection of content comprises hierarchically related data* (page 7).

Regarding claims 7, 37 and 67, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 6, 36 and 66, McGraw-Hill further disclose *the collection of content comprises text documents and the subset of content associated with each selectable object comprises at least one of a section* (pages 3 and 7).

Regarding claims 8, 38 and 68, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *displaying to the user the selected objects in a predetermined order such that the user may rearrange the order of the selected objects as desired through a user interface* (Review and Resequence, page 9).

Regarding claims 11, 41 and 71, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the step of *receiving content input by a user and creating a selectable object from the content* (pages 5-7).

Regarding claims 12, 42 and 72, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the user may concurrently create a plurality of compilations* (pages 7, 9 and 12).

Regarding claims 13, 43 and 73, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the step *presenting the compilation to a user for modification after creation of the compilation* (page Review and Resequence of page 9).

Regarding claims 14, 44 and 74, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 13, 43 and 73,

McGraw-Hill further discloses the step of *creating a copy of the compilation, applying changes input by a user to the copy, and creating a new compilation therefrom* (page 3).

Regarding claims 15, 45 and 75, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 13, 43 and 73, McGraw-Hill further discloses *the user may select an object for removal from the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 16, 46 and 76, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the user may select to clear the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 17, 47 and 77, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the user may select to undo an operation affecting the compilation*. However, undo an operation that affecting a compilation is a conventional operation such as the undo in Word Editor. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including the technique of undoing an object from a compilation in order to compile a document.

Regarding claims 18, 48 and 78, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the claimed *submitting the compilation to an approval process after*

creation of the compilation (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 19, 49 and 79, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 18, 48 and 78, McGraw-Hill further discloses *the approval process further comprises one of approving the compilation for publication; rejecting the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 20, 50 and 80, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the presenting step further comprises the step of presenting all of the content comprising the collection of content to the user as a plurality of selectable objects* (page 7).

Regarding claims 21, 51 and 81, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the presenting step further comprises the step of presenting less than all of the content comprising the collection of content to the user as a plurality of selectable objects* (pages 5-7).

Regarding claims 22, 52 and 82, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 21, 51 and 81, McGraw-Hill further discloses the step of *partitioning the collection of content into a plurality of categories, and presenting all content objects belonging to a category to a user* (page 5).

Art Unit: 2168

Regarding claims 23, 53 and 83, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the step of *receiving search criteria input by the user; determining which of the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of selectable objects corresponding to the subsets of content satisfying the search criteria* (pages 5-6).

Regarding claims 25, 55 and 85, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *a selectable object further comprises one of a container and a content entity* (page 7).

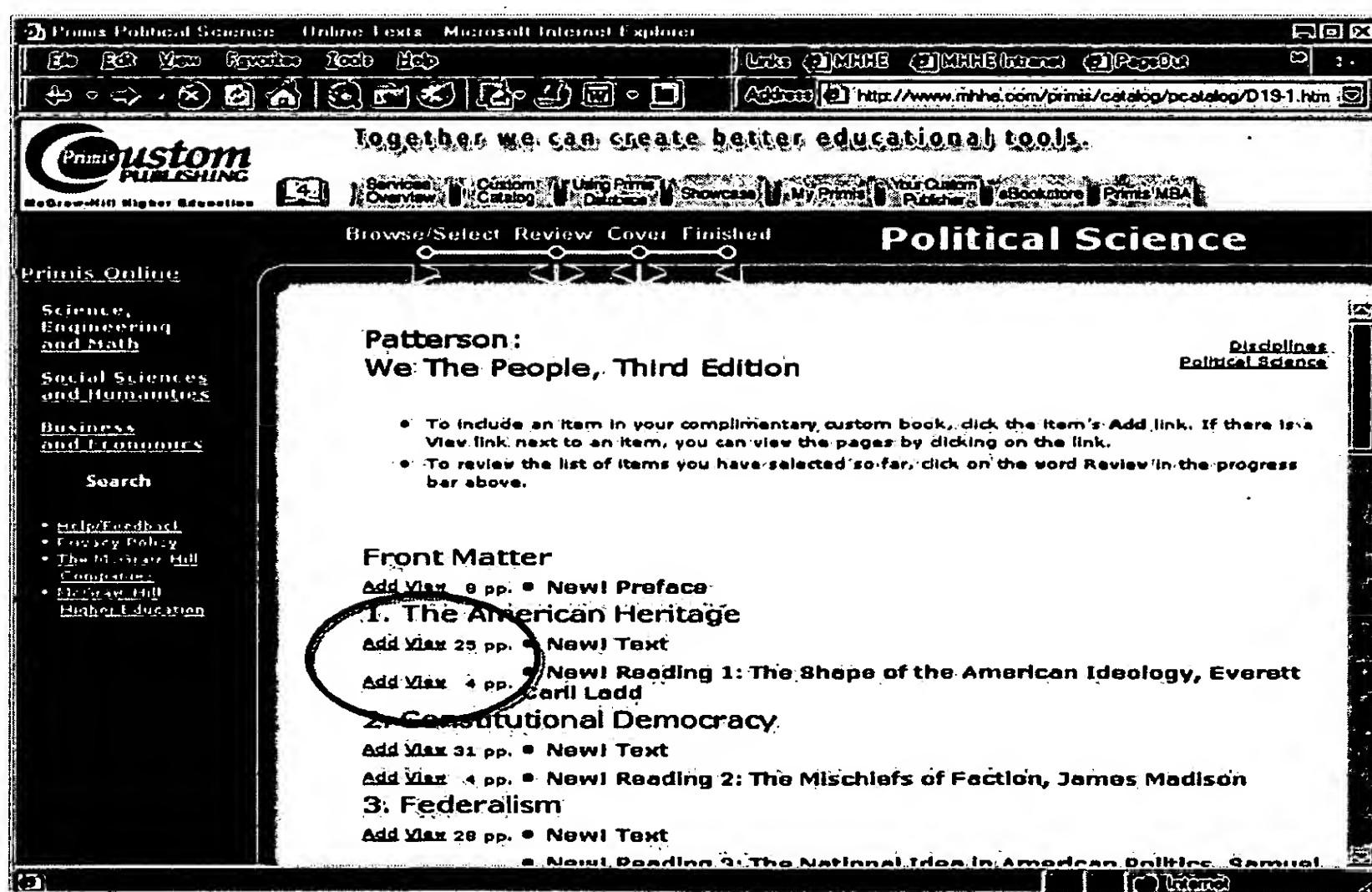
Regarding claims 26, 56 and 86, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85, McGraw-Hill further discloses *in response to selection of the container to add to a compilation, adding the selected container and any containers or content entities it contains to the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

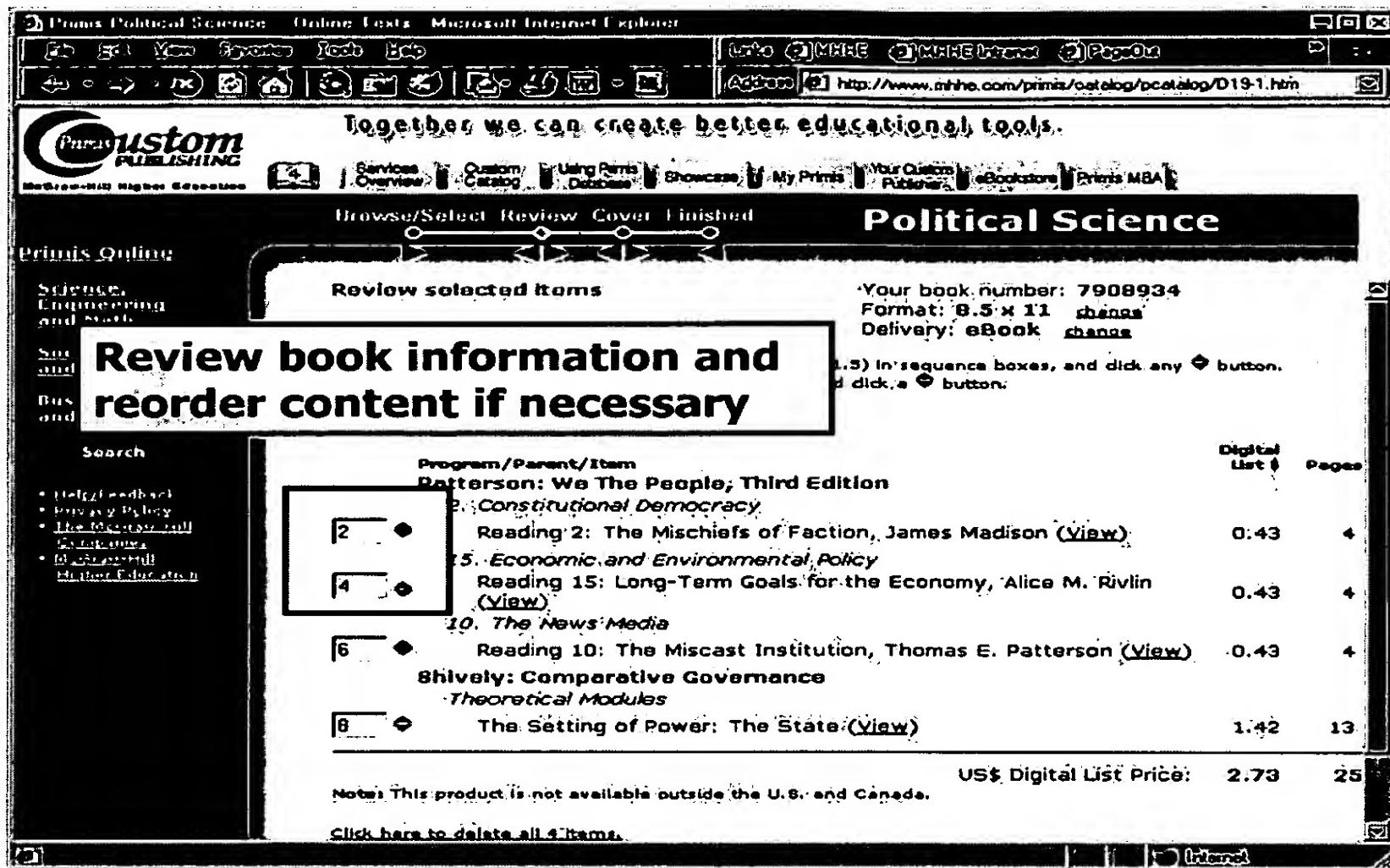
Regarding claims 27, 57 and 87, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the selectable objects further comprise titles of their associated subsets of content* (page 7).

Regarding claims 28, 58 and 88, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85, McGraw-Hill further discloses *containers are at least one of a book, a volume, and a chapter* (page 7).

Regarding claims 30, 60 and 90, McGraw-Hill discloses a method of compiling a customized textbook from a collection of content stored in a database (pages 1-3). The first screen shot indicates *a plurality of content objects stored in McGraw-Hill side as a digital library, each content object comprising a plurality of hierarchically related content entities.*

in response to selection one of the hierarchically related content entities to include in a hierarchical compilation (as in the first screen shot below, a user can select a hierarchically related content entity, e.g., chapter or section, to include in the process of compiling a hierarchical customized textbook), *creating a custom content object* (as indicated in the second screen shot below) *that specifies a compilation of a customized textbook from the selected content entities.*





As shown above is an e-book or *custom content object*, which is specified by book number 7908934, is created. The created e-book includes *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition". The e-book is provided in Adobe Acrobat format.

The missing of McGraw Hill is *one or more object servers*, a *library server* for storing the e-book, information and attribute of the e-book, and *a header of the e-book is user-modifiable*.

Warnock teach the technique of modifying the header of an electronic document in PDF format (Warnock, Col. 2, Lines 15-37). Warnock further discloses the technique of modifying a header of a PDF document by a user (Warnock, Col. 6, Line 66-Col. 7, Line 31). Thus, *a user modifiable header* is an inherited feature of document in PDF format.

As disclosed by Santamaki at Col. 5, Lines 6-16, a centralized server for storing the electronic written materials, and an e-book server for storing selected electronic written

Art Unit: 2168

materials that have been converted into an electronic book format to subsequent download to a terminal for viewing.

Thus, the Santamaki teaching of centralized server as *library server*, obviously, could be used for storing electronic written materials include *information specifying the custom content object*, e.g., "Reading 2: the Mischiefs of Faction, James Madison", and *attribute information concerning the custom content object*, e.g., "Patterson: We the People, Third Edition", and an e-book server as *object server*, obviously, could be used to store the e-book or *custom content object*.

By using centralized server as *library server*, and an e-book server as *one or more object servers* for storing information, the selectable text books and custom text book could be stored separately to distinguish the information between compiling and downloading process.

Regarding claims 91, 94 and 97, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the compilation of content is created automatically in response to the user selecting said one or more of said objects* (page 7).

Claims 2-3, 29, 32-33, 59, 62-63 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing], Warnock et al. [USP 5,634,064], Santamaki et al. [USP 6,886,036 B1] in view of Mortimer et al. [USP 6,091,930].

Regarding claims 2, 32 and 62, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the collection of content comprises at least one of a book, a document, an*

Art Unit: 2168

image but does not teach a *collection of musical selections and a video*. Mortimer teaches a technique of creating a customized student book and the collection of content comprises a collection of musical selections and a video (Mortimer, FIG. 2a). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including audio, and video in the collection of content in order to construct an electronic book embedded with audio, and video.

Regarding claims 3, 33 and 63, McGraw-Hill/Warnock, Santamaki and Mortimer, in combination, teach all of the claimed subject matter as discussed above with respect to claims 2, 32 and 62, McGraw-Hill further discloses *subsets of content comprise one of a chapter and sections of a text document* (McGraw-Hill, page 7).

Regarding claims 29, 59 and 89, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85, McGraw-Hill further discloses *the collection of content comprises at least one of a book* (McGraw-Hill, page 5). McGraw-Hill does not teach *the collection of content comprises at least one of image album and videos*. Mortimer teaches a technique of creating a customized student book and the collection of content comprises image album and a video (Mortimer, FIG. 2a). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including image and video in the collection of content in order to construct an electronic book embedded with image and video.

Claims 4-5, 34-35 and 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing],

**Warnock et al. [USP 5,634,064], Santamaki et al. [USP 6,886,036 B1] in view of
ksinclair.com [Free E-books You Can Download].**

Regarding claims 4, 34 and 64, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but fails to disclose *each selectable object is associated with a cost, and further comprising the step of calculating a cost for the created compilation based upon the costs of the selected objects.* Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. Ksinclair.com further discloses *each selectable object is associated with a cost* but fails to disclose the step of *calculating a cost for the created compilation based upon the costs of the selected objects.* However, a cost for a created compilation is a service charge based on the cost of maintaining an object such as an e-book and could be calculated upon the cost of that e-book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by applying the cost of an object from ksinclair.com method and including the cost of created compilation based upon the cost of the object in order to maintain the system.

Regarding claims 5, 35 and 65, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further disclosed the step of *determining a content count for the compilation* (McGraw-Hill, page 7), but not the step of *determining a cost for the compilation based upon the content count.* Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. The downloadable ksinclair.com e-book has a cost associated with the e-book (ksinclair.com). Thus

the cost of the compilation for a particular chapter could be calculated based upon the content count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by applying the cost of an object from ksclair.com method and including the cost of created compilation based upon the content count in order to maintain the system.

Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over by The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing], Warnock et al. [USP 5,634,064], Santamaki et al. [USP 6,886,036 B1] in view of Poole et al. [USP 6,006, 242].

Regarding claims 9, 39 and 69, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but does not disclose the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum*. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum* (Poole, FIG. 17). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by including the step of defining a maximum amount of content in order to compile an e-book online.

Regarding claims 10, 40 and 70, McGraw-Hill/Warnock, Santamaki and Poole, in combination, teach all of the claimed subject matter as discussed above with respect to claims 9, 39 and 69, Poole further discloses the step of *displaying to the user the selected objects contained in each volume such that the user may selectively move an object from a first to a second of the volumes* (Poole, Col. 11, lines 25-50).

Regarding claims 24, 54 and 84, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but does not explicitly disclose *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation.* Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation* (Col. 7, Lines 1-6). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique to include the nested object in order to compile an e-book with embedded pictures or graphics.

Regarding claims 92, 95 and 98, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object.* Poole teaches an apparatus and method for dynamically constructing an

electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object* (FIG. 5). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by referencing the content entities in order to compile an e-book.

Regarding claims 93, 96 and 99, McGraw-Hill/Warnock, Santamaki and Poole, in combination, teach all of the claimed subject matter as discussed above with respect to claims 92, 95 and 98, Poole further discloses *the computer-readable structure defining the compilation in a custom content outline (CCO) containing the references that correspond to the selected objects, and wherein said references are identifiers of the content entities associated with the selected objects* (FIG. 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HUNG Q PHAM
Examiner
Art Unit 2168

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